

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

IMPINJ, INC.,

Plaintiff,

v.

NXP USA, INC.,

Defendant.

Case No. 4:19-cv-03161-YGR

**IMPINJ, INC.'S MOTION FOR  
ADMINISTRATIVE RELIEF RE  
INCONSISTENT JURY VERDICT**

Hearing Date: July 25, 2023

Without Oral Argument

Judge: Hon. Yvonne Gonzalez Rogers

1 Pursuant to Civil Local Rule 7-11, Impinj, Inc. (“Impinj”) hereby brings this motion for  
2 administrative relief to correct an inconsistency in the jury’s verdict concerning the validity of U.S.  
3 Patent No. 9,633,302 (“the ’302 patent”).<sup>1</sup> Impinj has asked if NXP USA, Inc. (“NXP”) intends  
4 to seek a new trial on the validity of the ’302 patent, but as of the date of this Motion, has not  
5 received a response.<sup>2</sup>

6 After reviewing the jury’s verdict and instructions in more detail, Impinj respectfully  
7 requests that the jury be reconvened to address the internal inconsistency in the verdict regarding  
8 the validity of claims four and seven of the ’302 patent. The Court has the power to recall the jury  
9 for this purpose. *E.g., Dietz v. Bouldin*, 579 U.S. 40, 54, 136 S. Ct. 1885, 1897 (2016). While that  
10 power should be exercised rarely and cautiously, it may be justified in this case if NXP otherwise  
11 seeks a new trial on the validity of the ’302 patent. Reconvening the jury will be inconvenient,  
12 but Impinj respectfully submits that it is substantially less inconvenient for the Court than a new  
13 trial on the validity of the ’302 patent.

14 The jury’s verdict (*see* Dkt. 426) found that NXP had failed to prove that claims one and  
15 three of the ’302 patent were invalid as obvious, but had proven claims four and seven to be invalid  
16 as obvious. As a matter of logic, claims four and seven cannot have been found obvious if  
17 independent claim one was found non-obvious. Impinj respectfully submits that the jury was  
18 confused about how to address the validity of dependent claims three, four, and seven. This  
19 confusion was reflected in jury notes two and four. Jury note two asked “[c]ould we have some  
20 clarification of Section C? Is it asking us to evaluate the obviousness of each claim from other  
21 claims?” Dkt. 428 at 5. The Court answered “[t]he obviousness of each claim is measured against  
22 the prior art. Each claim is evaluated independently.” *Id.* Despite this answer, the jury asked a  
23 similar question in note four. In relevant part, the jury asked: “[d]o we need to decide about  
24 obviousness of claim 3 with consideration of claim 1?” *Id.* at 7.

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25 <sup>1</sup> Impinj also requested this relief via email to Chambers at 12:02 p.m. Pacific on July 18, 2023.

26 <sup>2</sup> Because Impinj has not received a response from NXP on whether it intends to move for a new  
27 trial on the validity of the ’302 patent, Impinj has not been able to obtain a stipulation from NXP  
28 on its requested relief pursuant to Civil Local Rule 7-12.

1 In response, counsel for Impinj suggested the jury was confused about the relationship  
2 between independent and dependent claims and “that they should be instructed that the limitations  
3 of Claim 1 are incorporated into Claim 3....” Tr. at 1401:20-22; *see also id.* at 1402:16-23 (“I  
4 think they’re confused because I think they’re going to think that the parallel lines somehow  
5 anticipates or is different than what is required by Claim 1. But as long as the Court tells them  
6 that the limitations of Claim 1 are incorporated into Claim 3, then I think it’s fine. I’m not sure  
7 just saying ‘dependent’ – they will understand that.”). The Court ultimately answered, in relevant  
8 part, “[c]laim 3 is dependent on claim 1. You should follow the Court’s instructions regarding  
9 dependent claims with respect to Claim 3.” Dkt. 428 at 7.

10 However, *the Court’s jury instructions did not explain the difference between independent*  
11 *and dependent claims. See Dkt. 427 passim.* The distinction appears to have been removed when  
12 Impinj withdrew its claim of infringement of dependent claim 12 of the ’597 patent, which was  
13 the only dependent claim before the jury for purposes of infringement. Accordingly, without an  
14 instruction on the difference between independent and dependent claims, the jury remained  
15 confused about the relationship of claim one to its dependent claims. This confusion led to the  
16 inconsistent verdict.

17 Impinj believes the most reasonable inference is that the dependent claims were found to  
18 be valid. This inference is reinforced by the fact that elsewhere the jury twice confirmed the  
19 validity of the ’302 patent. In the damages and willful infringement sections of the verdict form  
20 concerning the ’302 patent, the jury affirmed that there are valid claims of the ’302 patent. *See*  
21 *Dkt. 426 at 7-8.* NXP may argue, however, that the inconsistency between claim one and claims  
22 four and seven warrants a new trial on validity of the ’302 patent. In light of the burden a new  
23 trial would impose on all involved, particularly on the Court, Impinj respectfully submits that  
24 reconvening the jury for the limited purpose of resolving its inconsistent verdict is warranted.  
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1 DATED: July 18, 2023

2 By: /s/ Ramsey M. Al-Salam

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the above and foregoing document has been served via U.S. District Court CM/ECF notification on July 18, 2023 to all counsel of record.

/s/ Ramsey M. Al-Salam

Ramsey M. Al-Salam